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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,427	03/31/2004	Paul Buchheit	060963-5008US	8813
24341 7590 02/25/2009 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306				
EXAMINER				
STRANGE, AARON N				
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2453				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,427

Applicant(s)

BUCHHEIT ET AL.

Examiner

AARON STRANGE

Art Unit

2453

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 20090202
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 15-22 and 32-37 have been considered but are generally moot in view of the new ground(s) of rejection. However, some of Applicant's arguments have been addressed below.
2. With regard to claim 15, and Applicant's assertion that Moody does not return a list of conversations (Remarks 7-9), the Examiner respectfully disagrees. Moody discloses a search mechanism that locates messages matching certain criteria (§57) and also locates messages related to the matching messages, which may be messages in the same "thread" (§57). Threads are groups of messages determined to be related by some mechanism (§28). Once retrieved, the messages may be displayed in collapsed form, where a thread of related messages is displayed as an initial message that may be expanded to see other messages in the thread, so long as at least one message in the thread contains the search criteria used to locate the thread (§14; §59-60).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claim 20 is directed to a method of searching messages. None of the claimed steps are sufficient to tie the claimed method to a particular machine or apparatus. While the searching step recites a "message repository", the specification fails to provide any definition or description of the term "message repository" beyond its mere recitation. Therefore, the "message repository" is not a particular machine or apparatus. Additionally, none of the claimed steps transform any article into a different state or thing. Therefore, the claim does not qualify as a patent-eligible process claim. *See In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

6. All claims not individually directed are rejected by virtue of their dependency from the above claims and their failure to remedy the above noted deficiency.

Specification

7. Applicant's amendments to the specification filed April 22, 2008 have been entered and the objection to the specification set forth in the Office action of 9/10/2008 has been withdrawn.

Claim Objections

8. Claims 17, 19, 21, 34 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous

claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

9. Each of claims 17, 19, 21, 34 and 36 recite limitations that were added to their respective independent claims in the amendment filed 12/10/2008.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 15-22 and 32-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. With regard to claim 15, the limitation "wherein the predefined criteria includes ... information other than ... a reply-to field" is not described by the specification. The specification describes consideration of an "In-Reply-To:" field (e.g., ¶98), but makes no mention of a "reply-to field".

13. Independent claims 20, 32 and 37 contain a substantially identical limitation and are rejected under the same rationale.

14. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 15-22 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157) in view of Baldonado (US 7,035,903).

17. With regard to claim 15, Moody discloses a method of searching conversations, comprising:

at a server: (threading service 110 may be on server 108)(¶24)

receiving a search query from a client (client inputs search terms into query box 564)(¶54-57);

identifying a plurality of threads relevant to the search query (messages containing the search term, and all messages in the same thread are identified)(¶57), the plurality of threads including at least two threads each having two or more messages (at least the message containing the search term and the related message)(¶57) sharing a common set of characteristics that meet predefined criteria (the messages are part of the same "thread") and a respective conversation identifier (thread identifier)(¶57); and

returning the conversation to the client a list of the identified conversations as a search result to the search query (conversations containing the search terms are returned to the client)(¶57-60).

It is clear from the disclosure of Moody that the system will return a list of all messages satisfying the search criteria and their associated threads. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment.

However, Moody fails to specifically disclose that the predefined criteria includes a subject of the two or more messages and information other than the subject, a reply-to field, a references field and a message identifier field of the two or more messages, although Moody does disclose that the threading mechanism is not limited to any particular mechanism (¶28).

Baldonado discloses a similar system for identifying messages that are conversationally-related to each other (Abstract). Baldonado teaches matching

messages based on various criteria, including the subject of the messages (col. 4, ll. 65-66) and information other than the subject, a reply-to field, a references field and a message identifier field (e.g., location, recency, keyword, etc) (col. 4, ll. 62-67). This would have been an advantageous addition to the system disclosed by Moody since it would have allowed messages to be classified as being part of the same thread or conversation based on various criteria as desired by the user (Baldonado, col. 5, ll. 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to associate messages into conversations/threads based on various criteria including the subject of the messages and other non-subject criteria to allow users to define conversations/threads according to their desired classification.

18. With regard to claim 16, Moody further discloses that the identifying the conversation includes identifying a first message relevant to the search query (the message containing the search term)(¶57).

19. With regard to claim 17, Moody further discloses associating the first message to the conversation based at least in part on a subject of the message (messages that are part of the same share a "subject")(¶57) and information other than the subject of the message(keywords in the message)(¶57).

20. With regard to claim 18, Moody further discloses that associating the first message to the conversation based in part on information other than a normalized version of the subject of the message (keywords in the message)(¶57).

21. With regard to claim 19, Moody further discloses that associating the first message to the conversation based at least in part on a subject of the message (messages that are part of the same share a "subject") (¶57) and information other than one or both of a references field and an in-reply-to field (keywords in the message) (¶57).

22. With regard to claim 20, Moody further discloses a method of searching messages, comprising:

searching a message repository (Fig. 1 #110) to identify two or more messages (Fig. 5 #564) relevant to a search query, wherein each identified message is associated with a respective conversation (thread) of a plurality of conversations (Fig. 2 #224), each conversation having a respective conversation identifier (a thread identifier is inherently present to identify all messages in a thread), wherein at least one respective conversation of the plurality of conversations comprises two or more messages sharing a common set of characteristics that meet predefined criteria (at least the message containing the search term and the related message are part of the conversation) (¶0057);

identifying the respective conversation identifiers of the conversations associated with the one or more identified messages (each thread is identified and returned to the user) (¶0057);

creating a list of conversations, each of the conversations in the list corresponding to a respective identified conversation identifier (§0057-60); and producing at least a portion of the list of conversations as the search result (threads containing the search terms are returned and displayed)(§0057-60).

It is clear from the disclosure of Moody that the system will return a list of all messages satisfying the search criteria and their associated threads. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment.

However, Moody fails to specifically disclose that the predefined criteria includes a subject of the two or more messages and information other than the subject, a reply-to field, a references field and a message identifier field of the two or more messages, although Moody does disclose that the threading mechanism is not limited to any particular mechanism (§28).

Baldonado discloses a similar system for identifying messages that are conversationally-related to each other (Abstract). Baldonado teaches matching messages based on various criteria, including the subject of the messages (col. 4, ll. 65-66) and information other than the subject, a reply-to field, a references field and a message identifier field (e.g., location, recency, keyword, etc) (col. 4, ll. 62-67). This would have been an advantageous addition to the system disclosed by Moody since it would have allowed messages to be classified as being part of the same thread or conversation based on various criteria as desired by the user (Baldonado, col. 5, ll. 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to associate messages into conversations/threads based on various criteria including the subject of the messages and other non-subject criteria to allow users to define conversations/threads according to their desired classification.

23. With regard to claim 21, Moody further discloses that associating the first message to the conversation based in part on information other than a subject of the message (keywords in the message)(¶57).

24. With regard to claim 22, Moody further discloses that associating the first message to the conversation based in part on information other than a normalized version of the subject reference of the message (keywords in the message)(¶57).

25. Claims 32-37 are rejected under the same rationale as claims 15-20, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2453